

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

Group I, Claims 1-9, drawn to a shaped expanded graphite article.

Group II, Claims 10-18, drawn to a method of making a shaped expanded graphite article.

Applicants provisionally elect with traverse the invention of Group I (Claims 1-9) drawn to a shaped expanded graphite article.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are independent or patentably distinct.

The claims of Groups I and II are related as product and the process for making said product, and are considered to be interdependent and should be examined together on the merits, especially wherein the sole disclosed utility of the product is that disclosed in the specification. The claims of Group II further define the invention of Group I, and the refusal to examine the claims of Group II is a denial of substantive rights. The Examiner has failed to show, other than allege, that the claims of Group I can be made by another method than that recited in Group II. There is a commonality that exists between Groups I and II. It is a technical relationship that involves the same features, and it is this technical feature that defines the contribution which each of the groups taken as a whole makes over the prior art.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. Composition and method for making are considered related inventions under 37 C.F.R. § 1.475(b) and unity of invention between the groups exists.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants submit that a search of all claims would not constitute a serious burden on the Office. In fact the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction should now be required when the International Preliminary Examination Report did not, the restriction is believed to be proper. 37 C.F.R. § 1.475(b) provides in relevant part, that “a national stage application containing claims to different categories of inventions will be considered to have unity of invention if the claims are drawn only to . . . (3) a product, process especially adopted for the manufacture of said product.” In the instant application, Claims 1-9 are product claims that are being made by the process of Claims 10-18.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

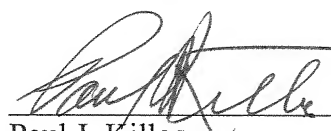
Applicants request that if the invention of Group I is found allowable, withdrawn Group II (which includes all the limitations of the allowable claims be rejoined.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)


Paul J. Killos
Registration No. 58,014